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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,889	08/31/2001	Shigeru Morino	01533/LH	2070
1933	7590	04/10/2006	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			HA, LEYNNA A	
220 Fifth Avenue			ART UNIT	
16TH Floor			PAPER NUMBER	
NEW YORK, NY 10001-7708			2135	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,889

Applicant(s)

MORINO, SHIGERU

Examiner

LEYNNA T. HA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-2 and 4-12 have been re-examined and remains pending.

Claim 3 was previously cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 23, 2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2 and 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moribatake, et al. (US 6,539,364) and further in view of Moskowitz, et al. (US 7,007,166).

As per claim 1:

Moribatake, Et al. discloses a method for encrypting and decrypting contents data to be distributed from a server to a user terminal through a network, said method comprising:

generating a first key at the server from contents information; **(col.4, lines 16-17 and col.13, lines 2-4)**

generating a second key at the server **(col.4, lines 56-67)** from a variable parameter received from the user terminal, a H/W key ID retrieved from a user information database **(col.7, lines 18-31)** by using a user ID received from the user terminal, and said first key, and then sending the generated second key to the user terminal; **(col.7, line 66 - col.8, lines 3)**

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decrypting the first key from at the user terminal from the variable parameter, the H/W key ID, and said second key is necessary to obtain the encrypted content **(col.10, lines 38-39 and col.12, lines 52-54)**

encrypting the contents data to be distributed at the server by using said first key and sending the encrypted contents data to the user terminal; and **(col.9, lines 61-63 and col.13, lines 40-41)**

decrypting the encrypted contents data at the user terminal by using said decrypted first key. **(col.10, lines 50-52 and col.13, lines 42-43)**

Moribatake teaches receiving contents from the user terminal and generating a first key from contents information but did not go into details that contents specifying data specifying the copyrighted electronic contents data to be distributed and the generated first key is from contents information relating to the copyrighted electronic contents data to be distributed.

Moskowitz teaches an invention related to a method and system for applying a digital watermark to a content signal wherein is a method of protecting copyrights (col.1, lines 38-45). Moskowitz teaches digital distribution of copyrighted content and key generation (col.5, lines 8-12) that distributes keys to better define rights (col.4, lines 50-57) that whom ever possesses this key can access the watermark (col.6, lines 47-49). Further, the keys are inserted into content to establish ownership rights and to be exchanged for delegating responsibilities to distributors or sales entities to restrict resale rights. Moskowitz teaches that recognition of copyrights as well as the desire to prevent piracy is a fundamental motive of enforcement which uses the mechanism of digital

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watermarks (col.5, lines 8-55). Therefore, it would have been for a person of ordinary skills in the art at the time of the invention is made for the contents of Moribatake to include copyright contents being distributed and and the generated first key is from contents information relating to the copyrighted electronic contents data to be distributed because copyrighting contents is to protect the copy and to prevent piracy where keys gives rights are involved to delegate responsibility to distributors or sales entities.

As per claim 2: See Moribatake on col.4, lines 45-46; discussing generating the variable parameter at the user terminal and sending the generated variable parameter to the server.

As per claim 3: Cancelled

As per claim 4: See Moribatake on col.5, lines 35-40 and 60-64; discussing synchronizing the variable parameter between the user terminal and the server.

As per claim 5: See Moribatake on col.5, lines 12-40 and 60-64; discussing synchronization between the user terminal and the server is performed at a time different from a time when the contents data is distributed.

As per claim 6:

Moribatake discloses contents data encrypting and decrypting system comprising:

- (i) a server which comprising;

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means for generating a first key from contents information; **(col.4, lines 16-17 and col.13, lines 2-4),**

means for generating a second key from a variable parameter **(col.4, lines 56-67),** a H/W key ID, and said first key, and

means for encrypting the contents data to be distributed by using the first key; and **(col.9, lines 61-63 and col.13, lines 40-41)**

(ii) a user terminal which comprising;

a network interface configured to send said contents specifying data to said server, and to receive said second key and said encrypted contents data from said server, **(col.3, lines 63-67 and col.7, line 18 - col.8, lines 3)**

means for decrypting the first key from the variable parameter, the H/W key ID, and said second key, and **(col.10, lines 38-39 and col.12, lines 52-54)**

means for decrypting said encrypted contents data by using said decrypted first key. **(col.10, lines 50-52 and col.13, lines 42-43)**

wherein the server receives the variable parameter received from the user terminal, and the server retrieves the H/W key ID from a user information database **(col.7, lines 18-31)** by using a user ID received from the user terminal, and said first key, in order to generate second key. **(col.7, line 66 - col.8, lines 3)**

Moribatake teaches receiving contents from the user terminal and generating a first key from contents information but did not go into details that contents specifying data specifying the copyrighted electronic contents data to be

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distributed and the generated first key is from contents information relating to the copyrighted electronic contents data to be distributed.

Moskowitz teaches an invention related to a method and system for applying a digital watermark to a content signal wherein is a method of protecting copyrights (col.1, lines 38-45). Moskowitz teaches digital distribution of copyrighted content and key generation (col.5, lines 8-12) that distributes keys to better define rights (col.4, lines 50-57) that whom ever possesses this key can access the watermark (col.6, lines 47-49). Further, the keys are inserted into content to establish ownership rights and to be exchanged for delegating responsibilities to distributors or sales entities to restrict resale rights. Moskowitz teaches that recognition of copyrights as well as the desire to prevent piracy is a fundamental motive of enforcement which uses the mechanism of digital watermarks (col.5, lines 8-55). Therefore, it would have been for a person of ordinary skills in the art at the time of the invention is made for the contents of Moribatake to include copyright contents being distributed and and the generated first key is from contents information relating to the copyrighted electronic contents data to be distributed because copyrighting contents is to protect the copy and to prevent piracy where keys gives rights are involved to delegate responsibility to distributors or sales entities.

As per claim 7: See Moribatake on col.5, lines 35-40 and 60-64;

discussing means for synchronizing the variable parameter between said server and said user terminal.

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As per claim 8:

Moribatake discloses a user terminal used in a system in which electronic contents data to be distributed from a server to the user terminal through a network is encrypted and decrypted, said user terminal comprising:

a network interface configured to send contents specifying data, and to receive from the server **(col.3, lines 63-67)** (i) a second key generated at the server from: a first key generated from contents information, a variable parameter received by the server from the user terminal **(col.4, lines 56-67)**, and a H/W key ID received by the server from a user information database by using a user ID received from the user terminal **(col.7, lines 18-31)**, and (ii) the contents data encrypted by using said first key; and **(col.7, line 66 - col.8, lines 3)**

a decrypting section configured to decrypt the first key from the variable parameter, the H/W key ID, and said second key **(col.10, lines 38-39 and col.12, lines 52-54)**, and then decrypt said encrypted contents data by using said decrypted first key. **(col.10, lines 50-52 and col.13, lines 42-43)**

Moribatake teaches receiving contents from the user terminal and generating a first key from contents information but did not go into details that contents specifying data specifying the copyrighted electronic contents data to be distributed and the generated first key is from contents information relating to the copyrighted electronic contents data to be distributed.

Moskowitz teaches an invention related to a method and system for applying a digital watermark to a content signal wherein is a method of protecting copyrights (col.1, lines 38-45). Moskowitz teaches digital distribution of

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copyrighted content and key generation (col.5, lines 8-12) that distributes keys to better define rights (col.4, lines 50-57) that whom ever possesses this key can access the watermark (col.6, lines 47-49). Further, the keys are inserted into content to establish ownership rights and to be exchanged for delegating responsibilities to distributors or sales entities to restrict resale rights. Moskowitz teaches that recognition of copyrights as well as the desire to prevent piracy is a fundamental motive of enforcement which uses the mechanism of digital watermarks (col.5, lines 8-55). Therefore, it would have been for a person of ordinary skills in the art at the time of the invention is made for the contents of Moribatake to include copyright contents being distributed and and the generated first key is from contents information relating to the copyrighted electronic contents data to be distributed because copyrighting contents is to protect the copy and to prevent piracy where keys gives rights are involved to delegate responsibility to distributors or sales entities.

As per claim 9: See Moribatake on col.4, lines 45-46 and col.5, lines 35-40 and 60-64; discussing the user terminal further comprising means for synchronizing the variable parameter between the server and the user terminal.

As per claim 10: See Moribatake on col.5, lines 12-40 and 60-64; discussing the contents information of the contents data comprises a size of the contents data and a preceding update date of the contents data.

As per claim 11: See Moribatake on col.5, lines 12-40 and 60-64; discussing the contents information of the contents data comprises a size of the contents data and a preceding update date of the contents data.

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As per claim 12: See Moribatake on col.5, lines 12-40 and 60-64;

discussing the contents information of the contents data comprises a size of the contents data and a preceding update date of the contents data.

Response to Arguments

4. Applicant's arguments with respect to claims 1-2 and 4-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEYNNA T. HA whose telephone number is (571) 272-3851. The examiner can normally be reached on Monday - Thursday (7:00 - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LHa



HOSUK SONG
PRIMARY EXAMINER